

**UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

SATCO PRODUCTS, INC.,
Plaintiff

v.

SIGNIFY NORTH AMERICA CORP. and
SIGNIFY NETHERLANDS B.V.,
Defendants

and

SIGNIFY NORTH AMERICA CORP. and
SIGNIFY HOLDING B.V.
Counterclaim-Plaintiffs,

v.

SATCO PRODUCTS, INC.,
Counterclaim-Defendant.

Case No. 6:21-cv-146-ADA

JURY TRIAL DEMANDED

CASE READINESS STATUS REPORT

Plaintiff/Counterclaim-Defendant Satco Products, Inc. (“Satco”) and Defendants/Counterclaim-Plaintiff Signify North America Corp., Defendant Signify Netherlands B.V., and Counterclaim-Plaintiff Signify Holding B.V. (collectively “Signify”) hereby provide the following status report in advance of the Case Management Conference (“CMC”).

FILING AND EXTENSIONS

Satco’s Complaint was filed on February 12, 2021. (Dkt. 1.) There has been one extension of 90 days for Signify to file an answer or otherwise respond to Satco’s Complaint. (Dkt. 13, 15.)

RESPONSE TO THE COMPLAINT

Signify filed an Answer and Counterclaims on May 17, 2021. (Dkt. 19.) In addition to

Counterclaims of non-infringement and invalidity, Signify's Counterclaims included ten (10) counts of patent infringement against Satco. (*Id.* at Counterclaims 7-16.)

Satco's response to the Counterclaims is due on June 7, 2021.

PENDING MOTIONS

There is no currently-pending motion in this case; however, Satco intends to move to dismiss seven of Signify's counterclaims of infringement because they are pending in the Eastern District of New York case that Signify brought against Satco on October 30, 2019, *Signify N. Am. Corp. et al. v. Satco Prods. Inc.*, Case No. 2:19-cv-06125 (E.D.N.Y.) (the "EDNY Case").

On May 24, 2021, Signify filed a pre-motion conference letter in the EDNY Case requesting a conference on its proposed motion to stay the EDNY Case pending a decision from this Court on Satco's forthcoming motion to dismiss Signify's counterclaims, or, in the alternative, to transfer the EDNY Case to this District.

RELATED CASES IN THIS JUDICIAL DISTRICT

There are no related cases in this District.

IPR, CBM, AND OTHER PGR FILINGS

There are no known IPR, CBM, or other PGR filings.

NUMBER OF ASSERTED PATENTS AND CLAIMS

Satco has asserted three patents and at least three claims against Signify. Signify has asserted ten patents and at least ten claims against Satco.

APPOINTMENT OF TECHNICAL ADVISOR

The parties have met and conferred. It is Signify's position that a technical adviser is not necessary in this case.

Satco's position is that a technical advisor is needed for four of the seven patents that are

part of the EDNY case (U.S. Patent Nos. 6,972,525, 7,038,399, 7,256,554, and 7,352,138) but not for the other patents asserted by Signify or for the patents asserted by Satco. Thus, whether a technical advisor is needed will depend on whether the Court grants Satco's forthcoming motion to dismiss.

MEET AND CONFER STATUS

Parties have met and conferred and have no pre-*Markman* issues to raise at the CMC.

Dated: May 24, 2021

Respectfully submitted,

/s/ Janis E. Clements

Janis E. Clements
Texas Bar No. 04365500
GREENBERG TRAURIG, LLP
300 W. 6th Street, Suite 2050
Austin, TX 78701
Telephone: (512) 320-7200
Facsimile: (512) 320-7210
Email: clements@gtlaw.com

Scott Bornstein (Admitted *Pro Hac Vice*)
Joshua L. Raskin (Admitted *Pro Hac Vice*)
Jeffrey R. Colin (Admitted *Pro Hac Vice*)
Julie P. Bookbinder (*Pro Hac Vice* pending)
GREENBERG TRAURIG, LLP
MetLife Building, 200 Park Avenue
New York, NY 10002
Telephone: (212) 801-9200
Facsimile: (212) 801-6400
Email: bornsteins@gtlaw.com
Email: raskinj@gtlaw.com
Email: ballj@gtlaw.com
Email: colinj@gtlaw.com
Email: bookbinderj@gtlaw.com

Robert P. Lynn, Jr. (Admitted *Pro Hac Vice*)
Katharine S. Santos (Admitted *Pro Hac Vice*)
LYNN GARTNER DUNNE, LLP
330 Old Country Road, Suite 103
Mineola, New York 11501
Telephone: (516) 742-6200
Email: rplynn@lgdlaw.com
Email: ksantos@lgdlaw.com

*Counsel for Plaintiff/Counterclaim-Defendant
Satco Products, Inc.,*

/s/ Brady Cox (with permission)

Brady Cox
Texas Bar No. 24074084
Alston & Bird LLP
2200 Ross Avenue, Suite 2300
Dallas, TX 75201
Phone: (214) 922-3400
Fax: (214) 922-3899
brady.cox@alston.com

Deron R. Dacus
Texas Bar No. 00790553
THE DACUS FIRM, P.C.
821 ESE Loop 323, Suite 430
Tyler, Texas 75701
Phone: (903) 705-1117
Fax: (903) 581-2543
ddacus@dacusfirm.com

*Counsel for Defendant/Counterclaim-Plaintiff
Signify North America Corp., Defendant Signify
Netherlands B.V., and Counterclaim-Plaintiff
Signify Holding B.V.*

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was electronically filed with the Court and that all counsel of record who are deemed to have consented to electronic service in the above-referenced case are being served this 24th day of May, 2021, with a copy of the above-document via the Court's CM/ECF System.

/s/ Janis E. Clements

Janis E. Clements